REMARKS

Claims 1-15 have been examined. By this Amendment, Applicants add new claims 16-18. Therefore, claims 1-18 are all the claims pending in the application.

Preliminary Matters

Applicants again request the Examiner to acknowledge the claim to foreign priority made on July 31, 2003 and receipt of the certified copy of the priority document filed on November 10, 2003. Applicants previously made the same request in the previous Amendment filed on January 30, 2007.

Allowable Subject Matter

Applicants thank the Examiner for indicating that claims 7, 8, and 15 contain allowable subject matter and would be allowable if rewritten in independent form. However, Applicants respectfully request the Examiner to hold in abeyance such rewriting of the claims until the Examiner has had a chance to reconsider and withdraw the rejection of the other claims.

Claim Rejections – 35 U.S.C. § 103

Claims 1-6 and 9-14 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Visvanathan *et al.* (U.S. Patent No. 6,359,643, hereinafter "Visvanathan") in view of Miyazaki (U.S. Publication No. 2005/0231631), and further in view of Tamashima (U.S. Patent No. 7,139,020). For *at least* the following reasons, Applicants respectfully traverse the rejection.

Applicants respectfully submit that claim 1 is patentable over the cited references. For example, claim 1 recites a digital camera comprising, *inter alia*:

- search means for reading the <u>compressed</u> motion picture data from said recording medium and for <u>detecting a frame where said marking data is added from the compressed motion picture data</u> read from the recording medium;
- motion picture decompression means for decompressing the frame and a predetermined number of frames in the neighborhood of the frame on a per frame basis each time the frame where said marking data is added is detected by the search means,
- playback means for replaying the decompressed frame,
- selection means for selecting an arbitrary frame displayed during playback by said playback means, and
- still picture data recording means for recording a frame selected by said selection means as still picture data onto said recording medium.

In the previous Office Action (dated November 30, 2006), the Examiner alleged that

Miyazaki's teachings disclosed the claimed playback means, selection means, and still picture

data recording means. The Examiner further alleged that it would have been obvious to a skilled

artisan to implement these teachings of Miyazaki (i.e., implementing a display, selection, and

storage system of Miyazaki) in the camera of Visvanathan (previous Office Action, page 3).

Further, the Examiner alleged that such a modified camera in Visvanathan would inherently

include the claimed search means.

However, in view of the arguments submitted by the Applicant in the Amendment filed

on January 30, 2007 and the Supplemental Amendment filed on April 16, 2007, the Examiner

acknowledges that the previous rejection of claim 1 was unclear, and now has altered his

proposed modification to Visvanathan's camera (Office Action, page 2).

Specifically, the Examiner now asserts that Visvanathan, in col. 3, lines 56-59, discloses

the claimed still picture data recording means which would store both video streaming data and

still image data (Office Action, page 3, lines 1-5). The Examiner further contends that the search

means is disclosed by step 316 in FIG. 3 of Visvanathan, where an application 210 on a host/PC

200 determines whether a frame that was transmitted from the camera 100 to the host/PC 200 is

indicated as a frame to be processed as a still image (Visvanathan, col. 5, lines 59-66).

Also, in this Office Action, it is alleged that a third party program performs the still image processing (allegedly the claimed playback means and the still picture selection means). Here, the Examiner alleges that Miyazaki's teachings of displaying frames preceding or subsequent to a subject frame for playback and selection can be implemented in the third party program (Office Action, page 6). Applicants respectfully submit that the proposed modification of Visvanathan and Miyazaki still does not disclose the claimed digital camera.

For instance, claim 1 recites that the digital camera comprises the search means, playback means, and selection means. That is, the search means, playback means, and selection means are on-board the claimed digital camera. On the other hand, the third party program (application program 210) in Miyazaki is on the host/PC 200, and not on-board the imaging system 100 (*see* Visvanathan: FIGS. 1 and 2, col. 3, lines 31-51, col. 4, lines 1-5, and col. 5, line 66 to col. 6, line 3).

Visvanathan unambiguously discloses that the host/PC 100 is external to the imaging system, and in fact, states that the application 210 is "device independent" (i.e., independent of the imaging system 100, see col. 4, lines 32-38 of Visvanathan). Video data captured by the imaging system 100 is transmitted to this device-independent application 210 for further processing (Visvanathan, col. 5, lines 10-13). This further processing, in this Office Action, is allegedly searching the captured image data for a marked frame, playing back the marked frame and a predetermined number of frames in the neighborhood of the frame (in view of Miyazaki's disclosure), and finally, selecting a frame to be recorded as still picture data during playback.

Since all these modified operations of Visvanathan are being carried out by components that are not on the imaging system 100 itself, and are instead on the host/PC 200 side, the proposed modification to Visvanathan's camera still does not disclose the claimed search means,

playback means and selection means of claim 1. That is, even if Miyazaki's teachings were combined with Visvanathan, it would still not result in the imaging system 100 of Visvanathan to include search means, playback means and selection means as set forth in claim 1.

Furthermore, Applicants respectfully submit that the prior art of record does not disclose search means for <u>detecting a frame where said marking data is added from the **compressed** motion picture data</u> read from the recording. For example, Visvanathan discloses that "once imaging system 100 has detected the still image capture command, signal and image processing unit 110 sets a STIL_EVENT_BIT in the start of the video frame (SOVF) header" (Visvanathan, col. 4, line 64 to col. 5, line 1). Visvanathan does not disclose that this captured video data is compressed before being transmitted to the host/PC 200. Moreover, if the captured video data was compressed, the SOVF header would also be compressed. <u>In this case, it would be impossible to detect the STILL_EVENT_BIT from the compressed video data, because the SOVF header would also be compressed</u>. Accordingly, Applicants respectfully submit that Visvanathan and Miyazaki, alone or in combination, do not disclose the claimed search means in as complete detail as set forth in the claim. Tamashima does not cure the deficient teachings of Visvanathan and Miyazaki.

In view of the above, Applicants respectfully submit that claim 1 is patentable over any conceivable combination of Visvanathan, Miyazaki, and Tamashima. Accordingly, Applicants respectfully request the Examiner to withdraw the 35 U.S.C. § 103(a) rejection of claim 1.

Claims 2-6 and 9-14 depend from claim 1. Therefore, claims 2-6 are patentable *at least* by virtue of their dependency. Moreover, claim 6, is patentable for the following additional reasons.

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For example, claim 6 recites that the playback means <u>replays the decompressed frame</u> <u>and the predetermined number of decompressed frames</u> in the neighborhood of the decompressed frame at a <u>playback speed</u> that is less than half of a regular playback speed of the playback means. The Examiner alleges that Miyazaki discloses this feature. In particular, the Examiner contends that the display of Miyazaki's image apparatus shown in FIG. 1, which shows a specific arrangement of images, discloses the noted feature of claim 6 because "the playback shown in Figure 1 does not change the frame". Applicants respectfully disagree and submit that the examiner is misapplying the teachings of Miyazaki.

The display shown in FIG. 1 of Miyazaki does not disclose <u>replaying</u> the collection of images at any <u>playback speed</u>, let alone replaying the collection of images at a <u>playback speed</u> <u>that is less than half of a regular playback speed</u> of the playback means. Replay or playback of images at any playback speed would imply that a playback speed exists. As the Examiner acknowledges, playback speed is given by number of frames displayed per unit of time (Office Action, page 7). The Examiner further concedes that FIG. 1 of Miyazaki does not disclose <u>any</u> <u>change of the frame</u>. FIG. 1 of Miyazaki merely shows a specific arrangement of pictures in one frame. If the frame is not changed, there is no replaying at a playback speed taking place in Miyazaki. That is, Miyazaki's image apparatus is merely <u>displaying one frame</u>, there is no <u>replaying</u> multiple frames at a <u>playback speed</u> as required by claim 6.

Therefore, Applicant respectfully submit that claim 6 is patentable over the references.

New claims

New claims 16-17 are patentable *at least* by virtue of their dependency to claim 1. Claim 18 is patentable for reasons similar to those given above with respect to claim 1.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed

to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is

kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue

Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any

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Respectfully submitted,

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Date: October 19, 2007